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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>11 July 2003</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-23</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-23</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>11 July 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

         1. ☐ Certified copies of the priority documents have been received.

         2. ☐ Certified copies of the priority documents have been received in Application No. _____.

         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This communication is a first Office Action Non-Final rejection on the merits.

Claims 1-23, as originally filed, are currently pending and have been considered below.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In claims 1-23, the method and system claimed is non-statutory because it fails to physically transform the information being stored to generate tangible results. Claims 1-10, CLAIM a business process execution engine which is not disclosed in the claims or the specification to be tangible and the method of using the engine fails to produce a tangible result thus it is an arrangement of data. Since it is a mere arrangement of data it is therefore nonfunctional descriptive material, which is nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   **Claims 1-4, 6, and 9-21are rejected under 35 U.S.C. 102(b) as being
anticipated by Dworkin (4,992,940).**

As per claim 1, Dworkin discloses a computer implemented method of
performing a business process (Abstract; discloses that the system includes a
programmed computer that interfaces with a database that contains a large number of
different products and/or services, arranged in various categories, the object of this
program is to select a vendor selling the desired product based on the criteria selected
by the user), the method comprising:

running in a business process execution engine a compiled business process
application that includes selection criteria for selecting partners (Abstract; disclose that
the user operates the system first by indicating the general type of product or service
desired, the system responds with a template. Upon receiving this template the user fills
in the selection criteria they deem to be significant. The program interface that is used
to gather information and compare it to the stored information on the database is
construed as the business process execution engine, and the partners being selected
are construed to be the vendors); and

utilizing the selection criteria to dynamically select a partner (Abstract; discloses
that the computer after receiving the selection criteria, the computer then searches the
database to retrieve all of the products or services that fit the users selection
requirements. The user can then find out more information about the vendors including
their prices and other information, from that information the user can make their
selection as to which vendor to purchase the goods from).

As per claim 2, Dworkin discloses receiving at least one attribute of the partner (Figure 7; discloses that the user can see information on the supplier such as supplier name, number, state, minimum order, terms accepted as far as payment, and any comments of the supplier, where the partner is construed to be the supplier).

As per claim 3, Dworkin discloses wherein the at least one attribute comprises identifying information (Figure 7; discloses that the user can see information on the supplies such as supplier name, where the partner is construed to be the supplier).

As per claim 4, Dworkin discloses wherein the at least one attribute comprises selection information (Figure 8; discloses the information based on the selection including the product manufacturer, model number, type, speed, and comments about the selection).

As per claim 6, Dworkin discloses wherein the at least one attribute comprises custom business partner data (Figure 7; discloses that the user can see custom information on the supplier under the field of comments of the supplier as well as the supplier name and supplier number).

As per claim 9, Dworkin discloses utilizing the at least one attribute of the partner while running the business process application (Figure 6; discloses a list of all the products that fit the criteria set by the user and the attribute that is utilized is the price of the corresponding product).

As per claim 10, Dworkin discloses while running the business process application, binding instances of a business partner variable to the partner identified in the selection (Col. 8, lines 30-33; discloses that each order is provided with a

transaction number which binds the instance of the search in this case a particular

product sold by a particular vendor for a set price with a number that will allow both the

vendor and the user access to the information on the exact order).

As per claim 11, Dworkin discloses a method of creating a computer

implemented business process, (Abstract; discloses that the system includes a

programmed computer that interfaces with a database that contains a large number of

different products and/or services, arranged in various categories, the object of this

program is to select a vendor selling the desired product based on the criteria selected

by the user, where the created business process is the purchasing of goods) the

method comprising:

defining a business process that includes criteria for selecting business partners

(Figure 3; discloses a list of possible activities the user can perform which defines the

different business process that the program is capable of performing. Col. 5, lines 43-

50; discloses that there are templates that are determined and programmed into the

program before the users is able to access the system, these templates and the menu

in which the user can access the system are all used to define the business process);

compiling the business process (Figure 2A; discloses the method the program

running the business processes are programmed where the menu is used to interface

the system the user can either perform a product search or other services. The program

to run all of these business processes are compiled once before the user can operate

the program);

dynamically managing business partners without recompiling the business process (Col. 10, lines 46-53; discloses that the operator of the system can update all of the information regarding the information stored in the database which would entail the management of business partners which are construed to be suppliers, since this information is stored on a database it is not necessary for the interface program to be recompiled).

As per claim 12, Dworkin discloses wherein dynamically managing business partners without recompiling the business process comprises adding business partners (Col. 10, lines 46-53; discloses that the operator of the system can update all of the information regarding the information stored in the database which would entail the management of business partners which are construed to be suppliers. This management would include the addition of new suppliers).

As per claim 13, Dworkin discloses wherein dynamically managing business partners without recompiling the business process comprises deleting business partners (Col. 10, lines 46-53; discloses that the operator of the system can update all of the information regarding the information stored in the database which would entail the management of business partners which are construed to be suppliers. This management would inherently include the deletion of new suppliers).

As per claim 14, Dworkin discloses wherein dynamically managing business partners without recompiling the business process comprises modifying attributes of business partners (Col. 10, lines 46-53; discloses that the operator of the system can update all of the information regarding the information stored in the database which

would entail the management of business partners which are construed to be suppliers. This would include modifying the attributes of business partners).

As per claim 15, Dworkin discloses wherein dynamically managing business partners without recompiling the business process is performed by at least one business partner (Col. 10, lines 46-53; discloses that the system can also be programmed to allow direct access, by suppliers, to the database, so that they suppliers themselves can update their information whenever necessary).

As per claim 16, Dworkin discloses wherein dynamically managing business partners without recompiling the business process comprises at least one business partner modifying at least one attribute of the at least one business partner (Col. 10, lines 46-53; discloses that the system can also be programmed to allow direct access, by suppliers, to the database, so that they suppliers themselves can update their information whenever necessary, from this it is shown that one business partner could modify their information without recompiling the business process).

As per claim 17, Dworkin discloses wherein the at least one attribute comprises price information (Figure 7; discloses that each supplier has a set price for each item being sold, Col. 10, lines 46-53; discloses that each supplier would be able to modify their own information which would include the prices of their products).

As per claim 18, Dworkin discloses wherein a computer readable medium containing computer-executable instructions for causing a computer device to perform a business process (Col. 4, lines 30-34; that the computer is programmed to execute the program which purpose is to aid in the selection and purchase of products which is the

business process), the instructions comprise: executing the business process that
includes selection criteria for selecting partners (Col. 2, lines 25-34; disclose that upon
using the program the user will be provided with a list of suppliers for the selected
product or service, including the price) such that business partner data can be modified
without modifying the business process (Col. 10, lines 46-53; discloses that the operator
of the system can update all of the information regarding the information stored in the
database which would entail the management of business partners which are construed
to be suppliers, without changing the program).

As per claim 19, Dworkin discloses a computer implemented system for
performing a business process (Abstract; discloses that the system includes a
programmed computer that interfaces with a database that contains a large number of
different products and/or services, arranged in various categories, the object of this
program is to select a vendor selling the desired product based on the criteria selected
by the user), the system comprising:

a computer readable medium containing a containing a business process
application that includes selection criteria for selection business partners (Col. 5, lines
35-50; discloses that the program is programmed to aid the using in selecting a product
when the user selects a type of product a template is shown to the user to aid them in
filling is selection criteria, upon entering the selection criteria different suppliers are
provided and the user can select the supplier based on additional information contained
in the system);

a computer readable medium containing a list of business partners and attributes of business partners (Col. 6, lines 32-35; discloses that the database stores all the possible vendors and the prices of their products. Figure 7; discloses the attributes that are stored about each supplier in the system); and

a business process execution engine that executes the business process application and selects business partners from the computer readable medium in accordance with the selection criteria (Col. 6, lines 32-35; discloses that based on the users selected item the database is searched and displays all of the vendors and their prices for the associated product).

As per claim 20, Dworkin discloses wherein attributes comprise contact information (Col. 4, lines 21-24; disclose that the system will contact the supplier showing that the system stores the contact information of the supplier, where the partner is construed to be the supplier).

As per claim 21, Dworkin discloses wherein the at least one attribute comprises price information (Figure 7; discloses that each supplier has a set price for each item being sold).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   **Claims 5, 8 and 23 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Dworkin (4,992,940), in view of Singh (US2001/0047311A1).

   As per claim 5, Dworkin discloses the above-enclosed invention, but fails to

disclose the use of digital certificates.

   Singh, which talks about a method for communicating, collaborating and

transacting commerce via a communication network, teaches wherein the at least one

attribute comprises a digital certificate (Paragraph 0041; teaches that for security

reasons buyers and suppliers will log on to the site and post orders while providing a

digital certificate to ensure that user is valid).

   From this teaching of Singh, it would have been obvious to one having ordinary

skill in the art at the time the invention was made to modify the system for finding a

supplier of a product provided by Dworkin with the use of digital certificates taught by

Singh, for the purpose of ensuring that the users of the system are valid and that the

transactions safe.

   As per claim 8, Dworkin discloses different document formats (Col. 4, lines 21-

24; discloses that the user can place an order using mail, electronic mail, and facsimile).

It is old and well known in the art at the time of then invention to identify a preferred

document format if the vendor has a specific way they would like to receive the

purchase order. Since the invention disclosed by Dworkin has the ability to display and

identify custom pieces of information from the vendor (Figure 7; discloses the comments

of the supplier where the supplier could display the request for a specific preferred

document format) it would be obvious to display a request for a specific document format.

Dworkin fails to disclose where the document format comprises an extensible markup language schema also known as XML.

Singh, which talks about a method for communicating, collaborating and transacting commerce via a communication network, teaches wherein the document format comprises an extensible markup language schema (Paragraph 0043; teaches that the data can be formatted according to an internet protocol-compliant language such as HTML or XML or the like).

From this teaching of Singh, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system for finding a supplier of a product provided by Dworkin with the use of XML formatting taught by Singh, for the purpose of providing the user a web based alternative to mail or e mail. The use of XML and HTML for the purposes of ordering products online became more widely used after the time of the Dworkin invention and would be an obvious improvement to the system.

As per claim 23, Dworkin discloses different document formats (Col. 4, lines 21-24; discloses that the user can place an order using mail, electronic mail, and facsimile). It is old and well known in the art at the time of then invention to identify a preferred document format if the vendor has a specific way they would like to receive the purchase order. Since the invention disclosed by Dworkin has the ability to display and identify custom pieces of information from the vendor (Figure 7; discloses the comments

of the supplier where the supplier could display the request for a specific preferred document format) it would be obvious to display a request for a specific document format.

Dworkin fails to disclose where the document format comprises an extensible markup language schema also known as XML.

Singh, which talks about a method for communicating, collaborating and transacting commerce via a communication network, teaches wherein the document format comprises an extensible markup language schema (Paragraph 0043; teaches that the data can be formatted according to an internet protocol-compliant language such as HTML or XML or the like).

From this teaching of Singh, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system for finding a supplier of a product provided by Dworkin with the use of XML formatting taught by Singh, for the purpose of providing the user a web based alternative to mail or e mail. The use of XML and HTML for the purposes of ordering products online became more widely used after the time of the Dworkin invention and would be an obvious improvement to the system.

7.   **Claims 7 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dworkin (4,992,940).**

       As per claim 7, Dworkin discloses different document formats (Col. 4, lines 21-24; discloses that the user can place an order using mail, electronic mail, and facsimile).

It is old and well known in the art at the time of then invention to identify a preferred document format if the vendor has a specific way they would like to receive the purchase order. Since the invention disclosed by Dworkin has the ability to display and identify custom pieces of information from the vendor (Figure 7; discloses the comments of the supplier where the supplier could display the request for a specific preferred document format) it would be obvious to display a request for a specific document format.

As per claim 22, Dworkin discloses different document formats (Col. 4, lines 21-24; discloses that the user can place an order using mail, electronic mail, and facsimile). It is old and well known in the art at the time of then invention to identify a preferred document format if the vendor has a specific way they would like to receive the purchase order. Since the invention disclosed by Dworkin has the ability to display and identify custom pieces of information from the vendor (Figure 7; discloses the comments of the supplier where the supplier could display the request for a specific preferred document format) it would be obvious to display a request for a specific document format.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL R. FISHER whose telephone number is (571)270-5097. The examiner can normally be reached on Mon/Fri [7:30am/5pm] with first Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on (571) 270-3033. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elaine Gort/
Primary Examiner, Art Unit 3627

PRF